

REMARKS

Claims 15-29 are pending in this application. Claims 1-14 were previously withdrawn and claim 30 was previously canceled. In view of the remarks contained herein, Applicants respectfully request reconsideration of the claims.

I. REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 15-17 and 23-29 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,337,173 to Jen, et al., (hereinafter “*Jen*”).

A. Improper Rejections

The Examiner continues to disregard the mandates of examination by failing to clearly articulate selected rejections so that Applicant has the opportunity to adequately respond. *See* MPEP § 706. In the pending Office Action, the Examiner failed to address or apply the teachings of the cited references to each individual claim. Instead, the Examiner merely provides a narrative that describes teachings that do not even appear to closely relate to the claims under examination. Moreover, the Examiner has again completely failed to provide specific cites to the reference used to support his § 102(b) rejection. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. 37 C.F.R. § 1.104(c)(2). The Examiner completely fails to provide even one specific cite from *Jen* in support of his § 102(b) rejection. This type of examination fails to provide the Applicant an opportunity to reply completely at the earliest opportunity. Applicant, therefore, respectfully requests the Examiner to properly examine the present application and provide Applicant a fair opportunity to respond.

B. Failure to Teach All Elements

To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim. *See* M.P.E.P. § 2131. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Moreover,

“[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.”
Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Claims 15 and 25 require, “providing a target.” The Examiner does not specify any part of *Jen* that corresponds to the claimed “target.” Claims 15 also requires the top surface of the target to have a “material layer,” while claim 25 requires the top surface of the target to have “a photoresist layer” with a “material layer” deposited over the photoresist layer. The Examiner does not specify any part of *Jen* that corresponds to the claimed “material layer” or “photoresist layer.” Claim 15 also requires “a first photoresist layer disposed over the material layer, a transparent spacer material disposed over the first photoresist layer, and a second photoresist layer disposed over the spacer material” The Examiner states that *Jen* teaches a photoresist layer, but does not state whether this photoresist layer corresponds to the claimed first or second photoresist layer. Moreover, the Examiner does not specify any part of *Jen* that corresponds to the claimed, “transparent spacer material.” The description written by the Examiner mentions a “window,” but it is clear from the *Jen* disclosure that this “window” is actually a recess patterned in an insulation layer and not a transparent material. Claim 25 also requires “providing a lithography reticle.” The Examiner does not specify any part of *Jen* that corresponds to a lithography reticle. *Jen*, therefore, does not teach each and every limitation of claim 15. Accordingly, claim 15 is allowable for at least the reasons discussed above. Applicant, therefore, respectfully requests that the rejection of claim 15 be withdrawn.

Claims 16, 17, and 23-29 depend from independent claims 15 and 25, respectively, and therefore inherit all the elements of their respective base claim. Accordingly, claims 16, 17, and 23-29 are allowable for at least the reasons discussed above. Applicant, therefore, respectfully requests that the rejection of claims 16, 17, and 23-29 likewise be withdrawn.

II. REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jen* in view of U.S. Patent No. 6,392,742 to Tsuji, *et al.* (hereinafter “*Tsuji*”).

In *Graham v. John Deere Co. of Kansas City*, the Supreme Court set out a framework for applying the statutory language of §103. 383 U.S. 1 (1966). The Court stated:

Under 35 U.S.C. §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *Id.*, at 17–18.

The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *KSR Int’l Co., v. Teleflex, Inc.*, 550 U.S. _____ (2007).

Patents for obvious combinations must generally be disallowed because a “patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 152 (1950). However, when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *United States v. Adams*, 383 U. S. 39, 51-52 (1966). Moreover, no holding or doctrine diminishes the necessity of the combined teachings or obvious elements teaching or suggesting each and every limitation of the claimed invention.

A. Improper Rejections

As noted above, the Examiner has again provided improper rejections to Applicant. The Examiner has summarized some of Applicant’s claims and then provided narrative summaries of the cited references (without specific citation except for his reference to claims 7-21 of *Tsuji*) in comparison. Applicant is entitled to a fair opportunity to respond to the Examiner’s rejections, and, thus, respectfully request the Examiner to provide a proper examination.

B. *Claims 18-22*

The Examiner admits that claims 18-22 do not teach using a reticle having transparent and opaque regions making up a holographic fringe representation of an image to be used in an exposure process. The Examiner offers *Tsuji* to cure this deficiency. However, as noted above, the Examiner has not established, nor does *Jen* teach or suggest, “providing a target,” where the top surface of the target has a “material layer,” or “a transparent spacer material,” as required by claim 15. Furthermore, the Examiner has not established which of the claimed “first photoresist layer” or “second photoresist layer” corresponds to *Jen*’s photoresist layer, and does not teach or suggest that a transparent spacer material is disposed on the first photoresist layer while a second photoresist layer is disposed over the spacer material. The Examiner does not offer *Tsuji* to cure these deficiencies, nor does *Tsuji* teach or suggest such limitations. Therefore, the combination of *Jen* and *Tsuji*, therefore, does not teach or suggest each and every limitation of claim 15. Claims 18–22 depend from independent claim 15 and therefore inherit all the elements of claim 15. Accordingly, claims 18-22 are allowable for at least the reasons discussed above. Applicant, therefore, respectfully requests that the rejection of claims 18-22 be withdrawn.

Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Thomas J. Meaney, Applicant's attorney, at 972-732-1001, so that such issues may be resolved as expeditiously as possible. No fee is believed due in connection with this filing. However, should one be deemed due, the Commissioner is hereby authorized to charge Deposit Account No. 50-1065.

Respectfully submitted,

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Date

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